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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,063	04/26/2001	Rabindranath Dutta	AUS920010005US1	8503

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EXAMINER	
CHEN, CHONGSHAN	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/843,063	DUTTA ET AL.	
	Examiner	Art Unit	
	Chongshan Chen	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5-9,18-23,27-29 and 33-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5-7, 18-21, 28 and 33-35* is/are rejected.

7)☐ Claim(s) *8,9,22,23,27 and 29* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 April 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *8/15/2005*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to Amendment filed on June 23, 2005. Claims 1, 5-9, 18-23, 27-29 and 33-35 are pending in this Office Action.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings and handwritings in the drawings are not clear. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

3. Examiner suggests the applicant to change the preamble of claims 1, 9 and 33 to "A computer implemented method ..." in order to avoid 101 problem.

4. Examiner suggests the applicant to change the "the stored screen captured images" in line 9 of claim 1 to "the stored captured screen images". Please review other claims and make similar corrections.

5. Examiner suggests the applicant to change the "determine the change of content" in line 5 of claim 9 to "determine the change ~~of~~ in content". Please make similar corrections to claims 23 and 29.

6. Examiner suggests the applicant to change the "wherein the at least one" in line 5 of claim 9 to "wherein ~~the~~ at least one". Please make similar corrections to claims 23 and 29.

7. Examiner suggests the applicant to change the "the stored screen capture images" in line 14 of claim 9 to "the stored captured screen images". Please review other claims and make similar corrections.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 28, 29 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 28, 29 and 35 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 22, line 21 – page 23, line 7, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., nonvolatile mediums) and intangible embodiments (e.g., communication links). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. Carrier medium and transmission media would be not statutory

but storage media would be statutory. Examiner suggests the applicant to change the "computer usable medium" to "computer storage medium".

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1, 18, 28 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (hereinafter "Moore", Pub. No.: US 2001/0039546 A1) in view of Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) and Pavley et al. (hereinafter "Pavley", US 6,317,141 B1).

As per claim 1, Moore discloses a method for displaying, at a client, transient message received over a network, the method comprising:

capturing, independently of a user action, at different times, a plurality of separate screen images, of only a portion of a display at the client, of a plurality of different multimedia objects each containing at least one transient message and each rendered on a portion of the display at the client (Moore, page 1, [0011]-[0015], page 2, [0021]-[0022], Moore teaches automatically capturing advertisements. It is well known that the advertisement is displayed in a portion of the browser, please see applicant's disclosure, page 3, lines 9-20. Therefore, Moore teaches automatically capturing a plurality of separate screen images, of only a portion of a display, of a plurality of different multimedia objects ...).

Moore further discloses storing each captured screen image of the multimedia object; and displaying the captured screen images (Moore, page 1, [0011]-[0015]), however, Moore does not explicitly disclose storing each captured screen image of the multimedia object, *in a chronological list*; and displaying the chronological list with control buttons for enabling a subsequent rendering of the stored screen captured images in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object from which the screen images were captured.

Engle teaches storing each captured screen image of the multimedia object, *in a chronological list* (Engle, page 2, [0020], [0022], Engle teaches storing the captured advertisements according to user-defined criteria, such as the date the ad was captured, and the captured ads can be sorted on the basis of the user-defined criteria. This stores the captured advertisements in a chronological list. Furthermore, it is well known in art that Windows Operating System stores a time stamp with any image/document/file, and the Windows Operating System can sort the images according to the timestamps. In this way, the images are stored in a chronological list). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moore by replacing the storing method of Moore with the storing method of Engle which stores the captured advertisements in a chronological list. The motivation being to store the advertisements according to user-defined criteria for display on browser at a later time (Engle, page 2, [0020]). When the user defines how he/she wants to store

the captured images, such as chronological order, it will be easier for the user to locate a particular image at a later time because he/she knows how it is stored.

Both Moore and Engle disclose replaying the captured advertisements (Moore, page 1, [0011]-[0013], Engle, page 2, [0020]). However, neither Moore nor Engle explicitly discloses displaying the chronological list with control buttons for enabling a subsequent rendering of the stored screen captured images in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object from which the screen images were captured. Pavley discloses creating a slide show for the captured objects (Pavley, col. 2, lines 15-20). A slide show displays a list of multimedia objects with control buttons for enabling a subsequent rendering of the objects and plays the list of multimedia objects in a forward and backward succession at a user configurable rate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Moore and Engle's combined system by incorporating a slide show program as disclosed by Pavley. The motivation being to allow the user to use the slide show program to create a slide show for the captured advertisements and play the captured advertisements in a forward and backward succession at a rate specified by user. This is much convenient for the user because the user does not need to select and play the advertisements one by one, the system automatically plays all the captured advertisements one by one to the user.

Claims 18, 28 and 33-35 are rejected on grounds corresponding to the reasons given above for claim 1.

12. Claims 5, 6, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (hereinafter "Moore", Pub. No.: US 2001/0039546 A1) in view of Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) and Pavley et al. (hereinafter "Pavley", US 6,317,141 B1) and Olah et al. (hereinafter "Olah", US 6,446,119 B1).

As per claim 5, Moore, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing the different times are determined by a configurable periodic interval. Olah teaches the different times are determined by a configurable periodic interval (Olah, Fig. 2-3, col. 6, lines 17-56, "Please enter the minutes of each hour of which you wish to save"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Moore, Engle and Pavley's combined system by capturing images at a configurable periodic interval as disclosed by Olah (Olah, Fig. 2-3). The motivation being to prompts the operator for the discrete moments at which the screen captures are to be executed (Olah, col. 6, lines 34-36). In this way, the system will automatically capture images at specific times. It saves the user from the burden of manually storing images at required times.

As per claim 6, Moore, Engle, Pavley and Olah teach all the claimed subject matters as discussed in claim 5, and further teach the configurable periodic interval occurs for a configurable duration of time (Olah, Fig. 2-3).

Claims 19 and 20 are rejected on grounds corresponding to the reasons given above for claims 5 and 6.

13. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. (hereinafter "Moore", Pub. No.: US 2001/0039546 A1) in view of Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) and Pavley et al. (hereinafter "Pavley", US 6,317,141 B1) and Hoang (US 6,014,183).

As per claim 7, Moore, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing the different times are determined by a change in content. Hoang teaches capturing images when detects a change in content (Hoang, col. 1, lines 52 – col. 2, lines 30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Moore, Engle and Pavley's combined system by capturing images when detects a change in content as disclosed by Hoang (Hoang, col. 1, lines 52 – col. 2, lines 30). The motivation being to eliminate the duplicated copies of images and save the storage space.

Claim 21 is rejected on grounds corresponding to the reasons given above for claim 7.

14. Claims 1, 18, 28 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant admitted prior art (Background of the Invention) in view of Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) and Pavley et al. (hereinafter "Pavley", US 6,317,141 B1).

As per claim 1, Applicant admitted prior art discloses a method for displaying, at a client, transient message received over a network, the method comprising:

capturing, independently of a user action, at different times, a plurality of separate screen images, of only a portion of a display at the client, of a plurality of different multimedia objects each containing at least one transient message and each rendered on a portion of the display at the client (Applicant admitted prior art, Background of the invention, page 7, lines 8-16, it is well known that the advertisement is displayed in a portion of the browser, please see applicant's disclosure, page 3, lines 9-20. Therefore, the Banner Console by i-LOR teaches automatically capturing a plurality of separate screen images, of only a portion of a display, of a plurality of different multimedia objects ...).

Applicant admitted prior art does not explicitly disclose storing each captured screen image of the multimedia object, *in a chronological list*; and displaying the chronological list with control buttons for enabling a subsequent rendering of the stored screen captured images in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object from which the screen images were captured.

Engle teaches storing each captured screen image of the multimedia object, *in a chronological list* (Engle, page 2, [0020], [0022], Engle teaches storing the captured advertisements according to user-defined criteria, such as the date the ad was captured, and the captured ads can be sorted on the basis of the user-defined criteria. This stores the captured advertisements in a chronological list. Furthermore, it is well known in art that Windows Operating System stores a time stamp with any image/document/file, and

the Windows Operating System can sort the images according to the timestamps. In this way, the images are stored in a chronological list). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of applicant admitted prior art (Banner Console by i-LOR) by storing the captured advertisements in a chronological list as disclosed by Engle. The motivation being to store the advertisements according to user-defined criteria for display on browser at a later time (Engle, page 2, [0020]). When the user defines how he/she wants to store the captured images, such as chronological order, it will be easier for the user to locate a particular image at a later time because he/she knows how it is stored.

Both applicant admitted prior art and Engle disclose replaying the captured advertisements (specification, page 7, lines 8-16, Engle, page 2, [0020]). However, neither applicant admitted prior art nor Engle explicitly discloses displaying the chronological list with control buttons for enabling a subsequent rendering of the stored screen captured images in a forward and backward succession, at a user configurable rate, in response to a user selection of one of the displayed control buttons, wherein the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object from which the screen images were captured. Pavley discloses creating a slide show for the captured objects (Pavley, col. 2, lines 15-20). A slide show displays a list of multimedia objects with control buttons for enabling a subsequent rendering of the objects and plays the list of multimedia objects in a forward and backward succession at a user configurable rate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant admitted prior art (Banner Console

by i-LOR) and Engle's combined system by incorporating a slide show program as disclosed by Pavley. The motivation being to allow the user to use the slide show program to create a slide show for the captured advertisements and play the captured advertisements in a forward and backward succession at a rate specified by user. This is much convenient for the user because the user does not need to select and play the advertisements one by one, the system automatically plays all the captured advertisements one by one to the user.

Claims 18, 28 and 33-35 are rejected on grounds corresponding to the reasons given above for claim 1.

15. Claims 5, 6, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant admitted prior art (Background of the Invention) in view of Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) and Pavley et al. (hereinafter "Pavley", US 6,317,141 B1) and Olah et al. (hereinafter "Olah", US 6,446,119 B1).

As per claim 5, Applicant admitted prior art, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing the different times are determined by a configurable periodic interval. Olah teaches the different times are determined by a configurable periodic interval (Olah, Fig. 2-3, col. 6, lines 17-56, "Please enter the minutes of each hour of which you wish to save"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant admitted prior art, Engle and Pavley's combined system by capturing images at a configurable periodic interval as disclosed by Olah (Olah, Fig. 2-3). The motivation being to prompts the operator for the discrete moments at which the screen captures are to be executed (Olah, col. 6, lines 34-36). In

this way, the system will automatically capture images at specific times. It saves the user from the burden of manually storing images at required times.

As per claim 6, Applicant admitted prior art, Engle, Pavley and Olah teach all the claimed subject matters as discussed in claim 5, and further teach the configurable periodic interval occurs for a configurable duration of time (Olah, Fig. 2-3).

Claims 19 and 20 are rejected on grounds corresponding to the reasons given above for claims 5 and 6.

16. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant admitted prior art (Background of the Invention) in view of Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) and Pavley et al. (hereinafter "Pavley", US 6,317,141 B1) and Hoang (US 6,014,183).

As per claim 7, Applicant admitted prior art, Engle and Pavley teach all the claimed subject matters as discussed in claim 1, except for explicitly disclosing the different times are determined by a change in content. Hoang teaches capturing images when detects a change in content (Hoang, col. 1, lines 52 – col. 2, lines 30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant admitted prior art, Engle and Pavley's combined system by capturing images when detects a change in content as disclosed by Hoang (Hoang, col. 1, lines 52 – col. 2, lines 30). The motivation being to eliminate the duplicated copies of images and save the storage space.

Claim 21 is rejected on grounds corresponding to the reasons given above for claim 7.

Allowable Subject Matter

17. Claims 8 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. Claims 9, 23, 27 and 29 would be allowable if rewritten or amended to overcome the claim objection and rejection(s) under 35 U.S.C. 101 set forth in this Office action.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571) 272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen
August 29, 2005

JEAN M. CORRIELUS
PRIMARY EXAMINER